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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/814,219
Filing Date: April 01, 2004
Appellant(s): COBURN, KATALIN

Samantha A. Updegraff
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1-5-10 appealing from the Office action mailed 9-10-09.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

1,687,154	BOLTON	10-1928
306,727	EDSON	10 1884
1,395,934	STOCKTON	11-1921
4,814,195`	YOKOYAMA et al.	03-1989
5,417,999	CAMMARN	05-1995

Rombauer, I. JOY OF COOKING, "Peanut Butter", 1975, Bobbs Merrill Co., Inc. MacMillan, Inc. NY, PAGE 564.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 5-8, 11-15, 18, 21, 22, 25, 29-33, 35-43, 45-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edson (306,727) or Rombauer et al. (page 564) in view of the prior art (specification page 7, lines 15-22) and Cammarn et al. (5,417,999) and Avera (3,615,590) and Stockton (1,395,934) and further in view of Yokoyama et al. (4,814,195).

Edson discloses a process of making a peanut paste by roasting peanuts and grinding the peanuts as in claim 1 (col. 1, lines 10-40). Applicant's specification on page 7, lines 15-21) discloses that it is known to make natural peanut butters without adding hydrogenated fats or emulsifiers. Rombauer disclose a process of making peanut butter by roasting and grinding nuts in amounts over 90% with oil (page 564, under "Peanut Butter) (claims 31, 32). This recipe does not contain any of the ingredients which have been excluded from the claims. Nothing is seen that the particle size of the paste would not have been coarse, since an electric blender was used. Claim 1 differs from the reference in the step of grinding to a coarse paste with a particular particle size, and claims 29, 30 differ from the reference in the use of unblanched peanuts, and claim 6 in having a particular temperature after the nuts are ground. Yokoyama et al. disclose a peanut butter, which uses 1/8 inch peanut particles

in a chunky peanut butter, which is within the claimed particle size (col. 9, lines 30-50). No mention is seen of blanching the nuts by Edson or Stockton. Cammarn et al. disclose that it is known to make peanut butter using unblanched white skinned peanuts (abstract) (col. 4, lines 60-70). Avera discloses as in claim 6, that roasting develops flavors and that grinding develops a temperature of about 160 F. (col. 2, lines 58-59, col. 4, lines 30-50).. Stockton discloses that the degree of oil separation can be prevented partially by coarse grinding, that the finer the grinding the more pronounced the tendency to gravitational separation (page 1, lines 89-103). Yokoyama et al. disclose that the claimed peanut particle size is known. Therefore, it would have been obvious to one of ordinary skill in the art to grind to a known particle size as shown by Yokoyama et al. in the process of Edson or Rombauer especially as Stockton teaches that the degree of oil separation can be prevented partially by coarse grinding, to use unblanched peanuts as disclosed by Cammarn et al, and to have a particular temperature after grinding the nuts, and to only use nuts and oil in the composition in the process of Edson and Rombauer et al.

The independent claims further require that the composition has a low fat content and a low oil separation, and does not rely on hydrogenated oils, stabilizers, emulsification processes and has a very low oil separation. Edson discloses applicant's process and does not require any of the ingredients or processes, which are not, required as in claim 1 has a low oil separation, as the process has been shown in combination. As above, if it is known that a particular degree of grinding keeps the nuts from exuding oil, then it would have been obvious to grind to the degree in which the

level of oil exudation is acceptable. Therefore, it would have been obvious to treat as claimed as shown by the above references.

Claims 1 and 14 further require particular sizes of nut particles. However, as above, it is known that oil separation can be partially prevented by coarse grinding; it would have been obvious to grind to particular degrees, which also allow for a minimum of oil exudation. Nothing has been shown that grinding as in Rombauer would have not produced the claimed particle size. Also, Yokoyama et al. disclose that the claimed coarse particle size is known as above. It is seen that it would have been within the skill of the ordinary worker to grind to any particle size, since grinding equipment is well known and coarse particle sizes are known as in crunchy peanut butter. Therefore, it would have been obvious to grind to levels, which still kept the oil from exuding since such is the aim of the coarse grinding.

Rombauer discloses a process as in claims 1, 5, 14, 31, 32, 33, 35, 42, 45-48 of using roasted nuts and oil, and grinding nuts in the amount of 90% of the composition with sugar and salt (page 564). Nothing is seen as in claims 1, 14, 33, 42 that the nuts are not coarse ground as only a blender is used in Rombauer. Also, Yokoyama et al. disclose that the claimed particle size is known and Stockton that coarse ground peanut particles exude less oil. Therefore, it would have been obvious to add other ingredients as shown by Rombauer and to make a coarse ground peanut particle peanut butter in the process of Rombauer or Edson.

Nothing is seen as in claim 25 that adding enough ingredients such as flavoring which are salt and sugar in Rombauer is not 0.75%. Therefore, it would have been

obvious to process nuts as disclosed by Rombauer in the process of the combined references.

Claim 43 further requires a particular dark color. However, as above it is known to roast to develop flavors, and it would have been within the skill of the ordinary worker to roast to a particular color. Therefore, it would have been obvious to roast to particular colors.

Certainly a temperature of from 145 to 165 F. as in claim 6 can be reached in any normal cooling step. It is not clear from the reference to Edson just what temperature is generated during the grinding step. Nothing is seen that it would not have been as claimed. Therefore, it would have been obvious to cool to temperatures below the grinding temperature.

Claim 7 further requires putting the peanut paste into an agitating, mixing bank. However, no weight is given to the type of apparatus in a process claim. Certainly, agitators such as mixers are well known. The reference discloses adding ingredients such as to the mixture (col. 2, lines 40-48). Therefore, it would have been obvious to add sugar or salt to the peanut mixture and agitate by known mechanical means.

Claims 8 and 38 further requires adding dried fruits into the peanut mixture. Edson discloses using peanut paste with sweetmeats, which are known to be candied fruits. Also, In re Levin applies. Attention is invited to In re Levin, 84 USPQ 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. In re Benjamin D. White, 17 C.C.P.A (Patents) 956, 39 F.2d 974, 5 USPQ 267; In re Mason et al., 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.Therefore, it would have been obvious to add fruit to the peanut paste and to use dried fruits for convenience. Nothing new is seen in adding extracts to the peanut mixture as in claim 23, and 26. See In re Levin as above.

Additional limitations such as mixing and blending for a particular length of time as in claim 11, using particular low temperatures as in claim 12 and pumping the mixture as in claims 13 and 41 are seen as obvious given the technology of the times.

The limitations of claims 14, 15, 18 have been disclosed above and are obvious for those reasons.

Edson discloses the use of peanuts as in claims 21 and 22.

Edson discloses adding flavorings such as sugar as in claim 18 (col. 2, lines 40-44). Avera discloses adding flavorings at within the claimed amounts. (col. 6, lines 28-

30). Therefore, it would have been obvious to add flavoring to a peanut butter, as disclosed by Avera in the process of Edson.

Claim 25 further require particular amounts of spices or flavorings. However, Edson discloses the addition of sugar, which is a flavorant (col. 2, lines 40-44). Nothing is seen that the amounts of one part of peanut past to seven parts of sugar would affect the amount of oil separation. In addition, the amounts are seen as within the skill of the ordinary worker as in claim 25. Therefore, it would have been obvious to add particular amounts of spices or flavorings to the claimed composition.

The limitations of claims 33 -36 have been disclosed above and are obvious for those reasons.

Claim 37 further requires mixing and blending the coarse nut paste and adding salt or sugar. Rombauer discloses adding sugar or salt to the peanuts. Nothing is seen that sugar and salt would not have been added to the nuts at the paste stage as nothing would have been gained in adding such during the grinding stage and it would be easier to determine how much to add if such were added during the paste stage. Therefore, it would have been obvious to add sugar and salt to the nut paste during the grinding stage.

The limitations of claim 38 have been disclosed above and are obvious for those reasons.

Cammarn et al. disclose adding sugar and salt and mixing for an additional 15 minutes as in claim 39 (col. 5, lines 1-15).

Claim 40 further requires mixing and blending at temperatures from 120 to 125 F. Nothing is seen in Rombauer that such temperatures are not present since grinding makes for heat. Nothing new is seen in blending at these low temperatures, since no ingredients such as hydrogenated oils and stabilizers are in the product, which would have required higher mixing temperatures. Therefore, it would have been obvious to not use very much heat if it was not required.

The further limitations of claims 42-43, 45-52 have been disclosed above and are obvious for those reasons.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the above references as applied to the above claims, and further in view of Bolton (1,687,154).

Claim 5 further requires that other ingredients be added to the peanut paste. This is so well known, that a reference is hardly required. Honey and jelly are well known ingredients, which are added to peanut paste as are sugar and salt. Also, Bolton discloses that it is known to add cucumbers to peanut butter (col. 1, lines 12-50). Therefore, it would have been obvious to add known ingredients to the peanut paste in the process of the combined references.

Claim 5 now requires that the ingredients are added during the grinding step. Stockton discloses that it is known to add salt in the grinding step (page 2, lines 62-65, col. 2, lines 1-75). Therefore, it would have been obvious to add flavoring ingredients in the grinding step in the process of the combined references.

ARGUMENTS

Appellant argues that Edson does not disclose grinding nuts to the coarse consistency with particles being from 1.5 to 3.5 mm. However, the reference is used in combination with other references that do show this limitation.

Appellant argues that Edson does have more ingredients than cited by the examiner. However, the part cited by the Examiner was to a peanut paste, made by grinding roasted nuts in a mill as claimed. Also, in col. 2, in claim 1, the process of making the paste is even claimed, and this mixture does not contain the other excluded ingredients of claim 1. The additional ingredients to make a candy are not required to make a nut paste.

Appellant argues that the composition of Edson contains flour or fluids, which are considered to be bulking agents, and that the reference must be used as a whole. Section 2123 (I) of the MPEP actually says in part “the use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain”. “A reference may be relied upon for all that it would have suggested to one of ordinary skill (in) the art, including non-preferred embodiments”. (2123 (I). It is not seen where applicant finds her citation as to the idea that the “references must be used as a whole and cannot be broken into pieces". At any rate, Edson was used for the teaching of making a peanut paste by roasting peanuts and grinding the peanuts as in claim 1 (col. 1, lines 10-40). Basic ground peanut is known as disclosed in

applicant's specification, and it is known that it is used in recipes as disclosed by Edson.

Appellant makes the same arguments for Rombauer, Yokoyama et al. and Bolton, that basically the references contain other ingredients than are claimed. The claims are open comprising claims. Rombauer does disclose grinding peanuts, and nothing has been shown that that degree of grinding would not have been within the claimed particle nut size. However, Yokoyama et al. disclose the claimed particle size, and Stockton discloses that it is known that the degree of oil separation can be prevented partially by coarse grinding, and that the finer the grinding the more pronounced the tendency to gravitational separation (page 1, lines 89-103).

Appellant argues that Yokoyama uses 1/8 inch peanut particles in a chunky peanut butter, and that the peanut 1/8 inch bits are incorporated into a smooth peanut butter-type base. However, this reference still discloses that chunky peanut butter sizes are known. 1/8 " is within the claimed size as disclosed by Yokoyama. If one wants a chunky peanut butter that is completely chunky, then that particle size could have been used since it is a known desirable size as evidenced by being used in the chunky peanut butter. This is what the reference was used for as above.

Appellant argues as to the phrase in her specification "that it is known to make natural peanut butters without adding hydrogenated fats or emulsifiers', that the specification goes on to say that the "resulting peanut butter… exhibits gravitational instability, i. e. oil separation on the top of the product". (page 7, lines 15-21, page, 8 and 9). However, this does not remove the fact that the above chunky peanut butters

are known. Rombauer discloses specifically grinding peanut butter to make a paste. No showing has been made as to the particle size of this reference, and even if one was made the particle size has been shown, as above. It is also known as disclosed by Stockton that it is known that the degree of oil separation can be prevented partially by coarse grinding, that the finer the grinding the more pronounced the tendency to gravitational separation.

Cammarn et al. was used for the teaching that it was known to make peanut butter using unblanched white skinned peanuts (abstract, col. 4, lines 60-70). Even if the peanut butter of Cammarn et al. used emulsifiers, which actually were not required in the use of the word "can" contain an emulsifier, and stabilizer, this is not what the references was used for. It is not seen what difference using white skinned peanuts would make as to whether large particle sizes were used and oil being formed makes. Edson and Stockton also do not disclose anything about the use of skins, and nothing has been shown that they add anything, but possible nutrition to the composition of the process. Also these limitations are not found in the independent claims.

Avera was used for the teaching that it is known, that roasting develops flavors, and that grinding develops a temperature of about 160 F., not the use of stabilizers, oils or blanched nuts or adding chunks to nut butter (col. 2, lines 58-59, col. 4, lines 30-50, col. 6, lines 45-50). The importance of not using blanched nuts is not seen when this limitation is not even in an independent claim. Breakage would have been obvious since this step would appear before one's very eyes, and is not considered inventive, when the choice is to use or not use blanched nuts, and nothing new or unobvious

comes from not using blanched nuts, particularly as appellant's nuts are used in the ground state. Picking and choosing is discussed above.

Even though Stockton does not use coarse ground peanut butter, but makes a finer ground peanut butter stabilized by the use of solid fat, the reference still discloses that the use of coarse grinding to prevent oil separation is known.

1. Appellant argues that Stockton teaches away from the use of coarse grinding to control oil separation because "[t]his difficulty of oil separation being foreseen may in only a very partial degree be prevented by coarse grinding; for the finer the grinding of the kernels the more pronounced the tendency to gravitational separation. But coarse ground peanut butter is less desirable. It is mealy and does not spread well, and furthermore it is less desirable, and furthermore it is less readily digested than fine ground butter. Another expedient that has been resorted to, to prevent in some measure this gravitational separation is to diminish the value of the fraction of oil in the mass...". However, this supposed "teaching away" does not negate the fact that coarse ground peanut butter was known, but not used for the above reasons. If appellant wants to make the above peanut butter it may be mealy and not spread well, as cited by Stockton.

Appellant argues as to MPEP section 2123(1) that the entire patent must be considered for all it contains. However, 2123(I) also states that "A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments". This sentence does not say that "the entire patent must be considered for all it contains". (para. 2, under section I. of 2123).

In this case the suggestion is that if one uses coarse ground peanut butter, that "oil separation being foreseen may in only a very partial degree be prevented by coarse grinding" (col. 2, lines 89-94). Certainly, if preventing oil separation to a partial degree is known, then little experimentation would have been required to come to "little" oil exudation, and it would have been expected to have more or less oil with various degrees of grinding.

Appellant argues that as to Bolton, that appellant is not adding cucumbers to the nut paste. However, the independent claims do not exclude adding cucumbers. Cucumber pickles are similar to adding spices and herbs in that they add flavor to the composition (col. 1, lines 8-11). Also, the reference was used to show that it was known to add other ingredients to the composition. In addition, water was not excluded by the claims.

As to the possible improper combination of claims, the references were used for what was cited as above and combined for the cited reasons. Appellant's analysis uses parts of the references that were not even cited to state that the combination was improper. Here the references as combined disclose that it is known to grind peanuts to a coarse size, which is known, to achieve a peanut butter free of additives, with little oil exudation. Certainly, products which do not contain the cited additives to make a "natural" product are well received by the public who often perceives additives as being harmful.

Even though the reason to modify the references was for a different purpose, such as Stockton's desire to make a peanut butter product which was smooth and did

not exude oil. He solved the problem of producing an oil layer when the nuts were finely ground by the use of a higher solidifying fat.

It is not agreed that the particle size has not been shown of 1.5 to 3.5 mm. Yokoyama et al. disclose the use of peanut bits having the size of 1/8 inch, or 3.175 mm, which is within the claimed range. The reference to imparted grittiness (col. 3, lines 58-70) in the reference actually refers to the bulking agent used to make a low calorie peanut butter (col. 3, lines 35-70). Yokoyama et al. is the only reference to show the actual particle size, except for Stockton who refers to "coarse grinding".

The further arguments in the summary have been addressed above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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